

REMARKS

The Final Office Action mailed February 26, 2003, has been received and reviewed. Claims 1 through 46, and 59 through 63 are currently pending in the application. Claims 33 and 45 stand rejected. Claims 34 through 40 and 46 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Claims 1 through 32, 41 through 44, and 59 through 63 are allowed. Applicant proposes to amend claims 33, 34, 45 and 46, and respectfully requests reconsideration of the application as proposed to be amended herein.

35 U.S.C. § 102(b) Anticipation Rejections**Anticipation Rejection Based on U.S. Patent No. 5,115,260 to Hayward et al.**

Claims 33 and 45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hayward et al. (U.S. Patent No. 5,115,260). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 33

Claim 33, as proposed to be amended herein, is directed to a strain control device. The strain control device includes: a body having a first end and a second end; and at least one cavity formed within a surface of the body between the first end and the second end, the at least one cavity configured to receive at least a portion of a transmission line therein, and wherein the at least one cavity defines a deviation path for the at least a portion of the transmission line *such that the at least a portion of the transmission line is enabled to be displaced between a first boundary of the at least one cavity and a second opposing boundary of the at least one cavity*

upon the elongation and contraction of the body. Applicant submits that Hayward fails to teach all of the limitations of claim 33.

The Examiner cites Hayward as disclosing all of the limitations of claim 33 and further states that “it has been held that the recitation that an element is ‘enabled to’ perform a function is not a positive limitation but only require the ability to so perform” and that such language “does not constitute a limitation in any patentable sense.” (Final Office Action, page 2, citing *In re Hutchinson*, 69 USPQ 138 (CCPA, 1946)).

Applicant respectfully disagrees with the Examiner’s position. Regarding the use of language “enabled to,” Applicant respectfully submits that the Examiner’s reliance upon *In re Hutchinson* is improper. *In re Hutchinson* involves an appeal with regard to the patentability of several apparatus claims. The Court of Customs and Patent Appeals (hereinafter, the “Court”) only analyzed one of such claims as being representative of all of the claims in question. In arguing the patentability of the representative claim, among other things, the applicant/appellant pointed to the following italicized claim language in order to distinguish over the prior art:

42. As an article of manufacture, *adapted for use in the fabrication of a metal template or the like suitable for metal-working operations*, a laminated unit comprising ... (*In re Hutchinson*, at page 140, emphasis in original).

The court considered such language and stated the following:

Taking first claim 42 for analysis and comparing it principally with the Moxon patent, the first phraseology italicized by appellant is the introductory clause to the effect that the laminated article is “*adapted*” for use in making a template or the like. This does not constitute a limitation in any patentable sense, but if it were in that category, it is anticipated by Moxon who teaches that his laminated sheet...may be used in making a template.” (*In re Hutchinson*, at page 141, emphasis in original).

Applicant notes that the Court's statement regarding the "adapted" language not constituting "a limitation in any patentable sense" appears to be dicta. This statement is clearly not necessary to the holding of the case since the Moxon reference anticipates the claim by explicitly teaching the same subject matter (including the use of the article as a "template") as expressly set forth by the Court.

Additionally, Applicant notes that the phrase being considered by the Court, including the term "adapted," is found in the "introductory clause," or the preamble, as expressly recognized by the Court. (*Id.*, at 141). It is a general premise in patent law that the mere statement of purpose or use in the preamble is given little, if any, weight in the patentability of a claim. (See MPEP § 2111.02).

Thus, with the Court's statement being dicta and not necessary to the holding of the case, and considering that the language in question was set forth in the preamble of the claim, Applicant submits that *In re Hutchinson* does not stand for the proposition that any language in a claim which is associated with the term "adapted" may be rendered as a non-limitation. Rather, Applicant submits that a correct reading of *In re Hutchinson* would simply provide that a statement of purpose or use (e.g., "adapted for use in the fabrication of a metal template") in the introductory clause or preamble does not generally act as a structural limitation in distinguishing the claim over the prior art.

Applicant, therefore, submits that *In re Hutchinson* is not applicable to claim 33 of the presently claimed invention. Claim 33 does not use the term "adapted" in any part of the claim. Furthermore, the language to which the Examiner points as failing to provide a patentable limitation is not "intended use" type language, nor is the subject language found in the preamble but, rather, in the body of the claim.

Taken in context, the language "enabled to be displaced" provides a positive structural limitation regarding the at least one cavity and the deviation path defined thereby as set forth in claim 33. More specifically, the language of claim 33 clearly establishes that the deviation path defined by the cavity is configured (not "may be configured" nor "capable of being configured") to allow the at least a portion of the transmission line to be displaced between the first boundary and the second opposing boundary of the deviation path.

Furthermore, the term “enabled,” as used in claim 33, is used with regard to a transmission line (or a portion thereof). The transmission line, while being recited in claim 33, is not positively recited as being part of the strain control device. Rather the at least one cavity of the strain control device, as set forth in claim 33, is configured to receive the at least a portion of the transmission line and, is structurally configured to *enable* the *transmission line* to be displaced in the recited manner. In other words, in order for the transmission line (or portion thereof) to be displaced between the two defined boundaries, the cavity (and deviation path defined thereby) must be *structured* to allow such displacement.

Thus, Applicant submits that the recitation of at least one cavity defining a deviation path for the at least a portion of the transmission line *such that the at least a portion of the transmission line is enabled to be displaced between a first boundary of the at least one cavity and a second opposing boundary of the at least one cavity* provides a clear and definitive structural limitation to the strain control device set forth in claim 33.

Applicant further submits that Hayward fails to teach such subject matter. Indeed, Hayward fails to teach a cavity which enables a portion of a transmission line to be displaced between two different boundaries of the cavity at any time while disposed therein. Rather, Hayward explicitly teaches that “each of [the] channels 24...is narrow enough *to ensure a pinch fit between the cables and the channel walls.*” (Col. 2, lines 45-48, emphasis added). With such a “pinch fit,” the cables are clearly constricted from being displaced between one boundary (wall) and another. As such, Applicant submits that claim 33 is clearly allowable over Hayward and respectfully requests reconsideration and allowance thereof.

Claim 45

Claim 45, as proposed to be amended herein, is directed to a strain control device. The strain control device includes: a body having a first grasping member configured to frictionally engage a first portion of a transmission line and a second grasping member configured to frictionally engage a second portion of the transmission line; and at least one cavity defined in the body between the first grasping member and the second grasping member, the at least one cavity being configured to accommodate a third portion of the transmission line therein and

defining a deviation path for the third portion of the transmission line *such that third portion of the transmission line is enabled to be displaced between a first boundary of the deviation path and a second opposing boundary of the deviation path upon elongation and contraction of the body*. Applicant submits that Hayward fails to teach all of the limitations of claim 45 as proposed to be amended herein.

The Examiner cites Hayward as teaching all of the elements of claim 45 and further states that "it has been held that the recitation that an element 'may' perform a function is not a positive limitation but only require the ability to so perform" and that such language "does not constitute a limitation in any patentable sense." (Final Office Action, page 3, citing *In re Hutchinson*, 69 USPQ 138 (CCPA, 1946)).

As set forth above with respect to claim 33, Applicant submits that the Examiner's reliance upon *In re Hutchinson* is improper. Specifically, *In re Hutchinson*, when considered in its entirety, merely provides that a statement of purpose or use in the introductory clause or preamble does not generally act as a structural limitation in distinguishing the claim over the prior art. Such is not applicable in the present case.

Applicant notes that claim 45 does not use the term "adapted" (as used in *In re Hutchinson*) in any part of the claim. Furthermore, the language to which the Examiner points as failing to provide a patentable limitation is not "intended use" type language, nor is the subject language found in the preamble but, rather, in the body of the claim.

Taken in context, the language "enabled to be displaced" provides a positive structural limitation regarding the at least one cavity and the deviation path defined thereby as set forth in claim 45. More specifically, the language of claim 45 clearly establishes that the deviation path defined by the cavity is configured (not "may be configured" nor "capable of being configured") to allow the third portion of the transmission line to be displaced between the first boundary and the second opposing boundary of the deviation path.

Furthermore, the term "enabled," as used in claim 45, is used with regard to a third portion of the transmission line. The transmission line, while being recited in claim 45, is not positively recited as being part of the strain control device. Rather the at least one cavity of the strain control device, as set forth in claim 45, is configured to receive the third portion of the

transmission line and is structurally configured to *enable* the *transmission line* to be displaced in the recited manner. In other words, in order for the third portion of transmission line to be displaced between the two defined boundaries, the cavity (and deviation path defined thereby) must be *structured* to allow such displacement.

Thus, Applicant submits that the recitation of at least one cavity defining a deviation path for the third portion of the transmission line *such that the third portion of the transmission line is enabled to be displaced between a first boundary of deviation path and a second opposing boundary of the deviation path* provides a clear and definitive structural limitation to the strain control device of claim 45.

Applicant further submits that Hayward fails to teach such subject matter. Indeed, Hayward fails to teach a cavity which enables a portion of a transmission line to be displaced between two different boundaries of the cavity at any time while disposed therein. Rather, Hayward explicitly teaches that “each of [the] channels 24...is narrow enough *to ensure a pinch fit between the cables and the channel walls.*” (Col. 2, lines 45-48, emphasis added). With such a “pinch fit,” the cables are clearly constricted from being displaced between one boundary (wall) and another. As such, Applicant submits that claim 45 is clearly allowable over Hayward and respectfully requests reconsideration and allowance thereof.

Objections to Claims 34 through 40 and 46/Allowable Subject Matter

Claims 34 through 40 and 46 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant submits that claim 33, from which claims 33 through 40 depend, and claim 45, from which claim 46 depends, are in condition for allowance and, therefore, so are claims 34 through 40 and 46.

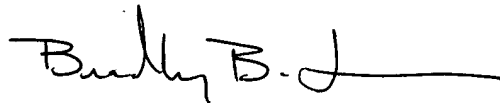
ENTRY OF AMENDMENTS

The proposed amendments to claims 33, 34, 45 and 46 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1 through 46 and 59 through 63 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



Bradley B. Jensen
Registration No. 46,801
Attorney for Applicant
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: April 25, 2003

BBJ/dlm:djp

Enclosure: Version With Markings to Show Changes Made

Document in ProLaw

VERSION WITH MARKINGS TO SHOW CHANGES MADE

33. (Three Times Amended) A strain control device comprising:
a body having a first end and a second end; and
at least one cavity formed within a surface of the body between the first end and the second end,
the at least one cavity configured to receive at least a portion of a transmission line
therein and wherein the at least one cavity defines a deviation path for the at least a
portion of the transmission line such that the at least a portion of the transmission line is
enabled to be displaced between [the] a first boundary of the at least one cavity and [the]
a second opposing boundary of the at least one cavity upon the elongation and contraction
of the body.

34. (Twice Amended) The strain control device of claim 33, wherein the at least one
cavity is at least partially defined by the first boundary and the second opposing boundary, and
wherein the [a] first boundary is a substantially linear boundary and [a] the second opposing
boundary [which] deviates from the first substantially linear boundary.

45. (Three Times Amended) A strain control device comprising:
a body having a first grasping member configured to frictionally engage a first portion of a
transmission line and a second grasping member configured to frictionally engage a
second portion of the transmission line; and
at least one cavity defined in the body between the first grasping member and the second
grasping member, the at least one cavity being configured to accommodate a third portion
of the transmission line therein and defining a deviation path for the third portion of the
transmission line such that third portion of the transmission line [may] is enabled to be
displaced between a first boundary of the deviation path and a second opposing boundary
of the deviation path upon elongation and contraction of the body.

46. (Twice Amended) The strain control device of claim 45, wherein the at least one cavity is at least partially defined by the first boundary and second opposing boundary, and wherein the [a] first boundary is a substantially linear wall and [a] the boundary is a second opposing wall which deviates from the first substantially linear wall.